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| POPOVICH, WILES & O'CONNELL, PA 650 THIRD AVENUE SOUTH SUITE 600 MINNEAPOLIS, MN 55402 | | | | |
| | | | EXAMINER LEE, JONG SUK | |
| | | | ART UNIT 3673 | PAPER NUMBER |

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,051

Applicant(s)

MACDONALD, ROBERT A.

Examiner

Jong-Suk (James) Lee

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/25, 3/31 & 6/20.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Page 1, line 4: -- U.S. Patent No.6,637,981 -- should be inserted after "filed August 14, 2002".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Poignard (US 6,115,983).

Pignard discloses a block assembly and wall construction comprising: at least a first lower course and a second upper course and each course comprising of first, second and third blocks, each block (12) having a thickness, width and length, the width of each block being different (see Fig. 1); each block having an upper surface spaced apart from an opposed lower surface, thereby defining the block thickness, the upper surface having a plurality of pin

Art Unit: 3673

receiving apertures (14), the lower surface having a channel (see Fig. 3-4); each block having opposed first and second faces, thereby defining the block length; each block having opposed side surfaces, thereby defining the block width; and a plurality of pins (16), each pin having a head portion and a body portion, the body portion of each pin being sized to be received in a pin receiving aperture, the head portion being larger than a pin receiving aperture and being sized to be received in a channel, the pins being configured such that when the wall is constructed from the wall block system, the head portion is configured to be received within the channel of the lower surface of a block in a first course of the wall and the body portion is configured to be received in one of the pin receiving apertures of a block in a next lower course of the wall (see Figs. 3-4); The first, second and third blocks comprise a core extending the thickness of the block (see Figs. 1-4; col.2, lines 49-67; col3, lines 1-64).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over poignard in view of Castonguay et al (US 6,024,517). The teachings of Poignard have been discussed above.

However, Poignard fails to disclose or fairly suggest the channel being parallel to and equidistant from the first and second faces. Castonguay et al discloses a retaining wall system

Art Unit: 3673

comprising a block (16) having a channel equidistant from a first and second face as depicted in Fig. 2 (see col.3, lines 38-59).

Therefore, in view of Castonguay et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Poignard's block by locating the channel to the center portion in order to provide the variation of the step width of the stacked blocks.

6. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over poignard in view of Hodel (US 5,161,918). The teachings of Poignard have been discussed above.

However, Poignard fails to disclose or fairly suggest the area of the first face being greater than the area of the second face. Hodel discloses a concrete retaining wall block having the area of a first/front face being greater than the area of a second face as depicted in Fig. 1 (see col.3, lines 21-49).

Therefore, in view of Hodel, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the shape of Poignard's block to be trapezoidal in order to efficiently curve the retaining wall according to the desired installation site.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Poignard as modified by Hodel, as applied to claim 5, and further in view of Castonguay. The teachings of Poignard modified by Hodel have been discussed above.

However, the teachings of Poignard modified by Hodel fails to disclose or fairly suggest suggest the channel being parallel to and equidistant from the first and second faces. Castonguay et al discloses a retaining wall system comprising a block (16) having a channel equidistant from a first and second face as depicted in Fig. 2 (see col.3, lines 38-59).

Therefore, in view of Castonguay et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Poignard's block modified by Hodel by locating the channel to the center portion in order to provide the variation of the step width of the stacked blocks.

Obviousness-Type Double Patenting

8. The nonstatutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and © may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 13, 16, 17 and 29 are rejected under the judicially created doctrine of

Art Unit: 3673

obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,149,352. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '352 patent, for example, in claims 13 of present claimed invention and claim 1-2 of '352 Patent, the Applicants claim:

" A wall having a front surface and a rear surface, the wall comprising: at least a first lower course and a second upper course, each course comprising a plurality of first, second, and third blocks; each block having an upper surface spaced apart from a lower surface, thereby defining a block thickness; each block having opposed and substantially parallel first and second faces, thereby defining a block length, the area of the first face being greater than the area of the second face; each block having opposed and non-parallel side surfaces, thereby defining a block width, the first and second faces being orthogonal to one of the side surfaces, the width of the first, second, and third blocks being different; and the blocks being positioned in the courses such that the front surface of the wall is comprised of the first faces of a plurality of the first blocks, the second faces of a plurality of the second blocks and the second faces of a plurality of the third blocks to thereby provide a front wall surface having the irregular block pattern."

whereas in '352 Patent, the Applicants claim "...each block having opposed and substantially parallel first and second faces the first face having an area greater than the second face; each block having opposed and non-parallel side surfaces, the first and second faces being orthogonal to one of the side surfaces, the first and second faces together with the upper lower and side surfaces forming a block body;..... the first faces of a plurality of blocks and the second

Art Unit: 3673

faces of a plurality of the blocks to thereby provide an irregular block pattern" (see claim 1; col.13, lines 4-11); and

".....the width of the first, second and third blocks being different, the blocks being positioned in the courses such that the front surface of first, second and third blocks and the second faces of a plurality of the first, second and third blocks...." (see claim 2, line 19-24)

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-7 of '352 patent as a general teachings for a wall block system and a method for constructing a wall from wall blocks as claimed by the present application. The instant claims obviously encompass the claimed invention of '352 Patent. To the extent that the instant claims are broaden and therefore generic to the claimed invention of '352 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

10. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,447,213.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '213 patent because the limitations of all claims of the present application are almost identical to the claims of the '213 patent except the limitation, "the first face, the second face and at least one side surface being textured in a manner resulting in the appearance of natural stones" which is

Art Unit: 3673

recited in dependent claims in the present application, or almost identical to the claims of the '981 patent.

For example, in claims 21 of present claimed invention and claim 40 of the '213 Patent, the Applicants claim:

A method claim, "... providing wall blocks having an upper surface spaced apart from a lower surface, thereby defining a block thickness, opposed and substantially parallel first and second faces, the first face having an area greater than the second face, opposed and non-parallel side surfaces, the first and second faces being orthogonal to one of the side surfaces, the first and second faces together with the upper, lower and side surfaces forming a block body; and laying the wall blocks in a first course of the wall and a second course of the wall such that the front surface of the wall is formed of the first faces of a plurality of the wall blocks and the second faces of a plurality of the wall blocks."

Whereas in '213 Patent, the Applicants claim "...providing wall blocks, each of the wall blocks having an upper surface spaced apart from.....; opposed and substantially parallel first and second faces, the first face having an area greater than the second face, opposed and non-parallel side surfaces, the first and second faces being orthogonal to one of the side surfaces....; and laying the wall blocks in a first course of the wall and a second course of the wall such that the front surface of the wall is formed of the first faces of a plurality of the wall blocks and the second faces of a plurality of the wall blocks." (see claim 40; col.18, lines 31-49).

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-41 of the '213

Art Unit: 3673

Patent as a general teachings for a wall block system and a method for constructing a wall from wall blocks as claimed by the present application. The instant claims obviously encompass the claimed invention of the '213 Patent. To the extent that the instant claims are broaden and therefore generic to the claimed invention of the '213 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

11. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-23 of U.S. Patent No. 6,637,981.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '981 Patent.

For example, in claims 1 of present claimed invention and claims 9-10 of the '981 Patent, the Applicants claim:

An apparatus claim; "...first, second, and third blocks, each block having a thickness, width and length, the width of each block being different; each block having an upper surface spaced apart from an opposed lower surface, thereby defining the block thickness, the upper surface having a plurality of pin receiving apertures, the lower surface having a channel; each block having opposed first and second faces, thereby defining the block length; each block having opposed side surfaces, thereby defining the block width; and a plurality of pins, each pin having a head portion and a body portion, the body portion of each pin being sized to be received in a pin receiving aperture, the head portion being larger than a pin receiving aperture and being

sized to be received in a channel, the pins being configured such that when the wall is constructed from the wall block system, the head portion is configured to be received within the channel of the lower surface of a block in a first course of the wall and the body portion is configured to be received in one of the pin receiving apertures of a block in a next lower course of the wall.”

Whereas in the ‘981 Patent, the Applicants claim, “the first, second and third blocks, each block having a thickness, width and length, the width of each block being different; each block having an upper surface spaced apart from a lower surface, thereby defining a block thickness; each block having opposed and non-parallel side surfaces, thereby defining the block width; and the first, second, and third blocks being configured.....” (claim 9; col.14, lines 40-col.15, line 4) and;

“....a plurality of pins, each pin having a head portion and a body portion, the pins being configured such that when the wall is constructed from the wall block system, the head portion is configured to be received within the channel of the lower surface of a block in a first course of the wall and the body portion is configured to be received in one of the pin receiving apertures of the second blocks in a next lower course of the wall.” (claim 10; col.15, lines 7-13).

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 9-23 of the ‘981 Patent as a general teachings for a wall block system and a method for constructing a wall from wall blocks as claimed by the present application. The instant claims obviously encompass the claimed invention of the ‘981 Patent. To the extent that the instant claims are broaden and

Art Unit: 3673

therefore generic to the claimed invention of the '981 Patent [species], *In re Goodman* 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application

12. The obviousness-Type double patenting rejection is based on a judicially created doctrine grounded in public policy is primarily intended to prevent the prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application of patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130 (b).

Allowable Subject Matter

13. Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and **upon timely filing of Terminal Disclaimer.**

14. Claims 13-29 would be allowable over the prior art of record **upon timely filing of Terminal Disclaimer.**

Art Unit: 3673

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose a block module and wall block system and method.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk James can be reached on (703) 308-6777, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
July 15, 2004



**Jong-Suk (James) Lee
Primary Examiner
Art Unit 3673**